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In re Application of
Roy Neil McHUTCHINSON
PCT No.: PCT/AU01/00844
Application No.: 10/088,181
Int. Filing Date: 13 July 2001
Priority Date: 14 July 2000
Attorney's Docket No.: 3955.117USWO
For: TAMPER PROOF SLIDE COVER
CONTAINER

: DECISION ON
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: PETITION UNDER
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: 37 CFR 1.47(b)
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This decision is in response to applicant's "PETITION UNDER 37 CFR 1.47(b)" submitted on 11 December 2002 that seeks the acceptance of the application without the signature of the inventor Roy Neil McHUTCHINSON. Petitioner has submitted the requisite \$130 petition fee by check.

BACKGROUND

On 13 July 2001, applicant filed international application PCT/AU01/00844, which claimed priority of an earlier Australian application filed 14 July 2000. A copy of the international application was transmitted to the United States from the International Bureau on 24 January 2002. No Demand was filed for this application. Accordingly, the twenty-month period for paying the basic national fee in the United States expired at midnight on 14 March 2002.

On 14 March 2002, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, inter alia, the requisite basic national fee as required by 35 U.S.C. 371(c)(1). However, no executed declaration or oath was submitted at such time.

On 12 June 2002, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 indicating that "the oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. The notification also indicated that the surcharge for filing the oath or declaration later than 20 months from the priority date as required by 37 CFR 1.492(e) must be filed. The notification set two months from the date of this notice or 22 months from the priority date for the application, whichever is later. Failure to properly respond will result in abandonment."

In an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4), applicant filed on 11 December 2002, the following:

- 1) a petition under 37 CFR 1.47(b);
- 2) a Declaration And Power of Attorney unsigned;
- 3) Declaration by Charles Frederick Sharland
- 4) the required petition fee.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Applicant has satisfied items (1), (2), and (3), and but not items (4) - (6) thus not completing the requirements under 37 CFR 1.47(b).

Applicant has satisfied item (1) since the petition fee has been provided by applicant.

Regarding requirement (2), applicant has provided sufficient evidence that Roy Neil McHutchinson refused to sign the declaration.

Regarding item (3), applicant has stated the last known address of the inventor:

Roy Neil McHutchinson
67 Douglas Avenue
South Perth
Western Australia, 6151, Australia

Regarding item (4) a declaration has not been provided executed by an appropriate officer of company on behalf of the non-signing sole inventor, Mr. McHutchinson.

Regarding item (6) applicant has not presented an adequate showing that the granting of this petition is necessary to preserve the rights of the parties or to prevent irreparable damage.

Regarding item (5) applicant has not submitted proof that applicant has sufficient proprietary interest in the application. Mr. Sharland's statement is not sufficient without corroborating evidence since there is no copy of the assignment (signed assignment by inventor Mr. McHutchinson) provided with this petition.

If the application has been assigned, a copy of the assignment (in the English language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant prior to the date the application is deposited in the Patent and Trademark Office.

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by affidavit or declaration that those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by the affidavit or declaration of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

If the invention has not been assigned, or if there is no written agreement to assign, the 37 CFR 1.47(b) applicant must demonstrate that he or she otherwise has a sufficient proprietary interest in the matter.

A proprietary interest obtained otherwise than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record. Note MPEP 409.03(f)


Accordingly, it is not appropriate to accord the national stage application status under 37 CFR 1.47(b) at this time.

CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


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